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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/753,270

Filing Date: January 08, 2004

Appellant(s): FEYGENSON ET AL.

Phillip M Pippnger; reg. 46055
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 31, 2010 appealing from the Office action mailed May 21, 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 16-19 and 21-32

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Rejection of claim 20 under 35 USC 101 because the claim has been withdrawn.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

www.medquist.com retrieved from wayback machine(www.archive.org) any link June 8, 2003.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

5 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof,, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-32 are rejected under 35 U.S.C. 101 because the claims do not limit any process step to any specific machine/apparatus or transformation of an article. The machine or transformation test is a two-branch inquiry; an applicant may show that a

process claim satisfies 101 either by showing that his claim is tied to a particular machine or by showing that his claim transforms an article. Furthermore, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. (See *In re Bilski*)

Claim Rejections - 35 USC § 112

Claims 21-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are directed to the identification of an “independent individual contractor”. One skilled in the art would not reasonably convey that a potential candidate for an employer would be understood to be an “independent individual contractor”. Applicant fails to disclose a contractor as a candidate therefore leaving the claim limitations narrower than that of the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,567,784 Bukow; Method and Apparatus for Matching Projects and Workers. Hereinafter referred to as Bukow.

As to claim 16 Bukow discloses:

Determining necessary tasks to be performed(C. 1 l. 33-37).

Submitting the need for someone to perform the certain tasks that are capable of being performed over the internet(C. 2 l. 60-65).

Choosing a candidate that meets the requirements of the task(C. 3 l. 34-40).

Negotiating pay for the task(C. 5 l. 63-67).

Paying the candidate the negotiated price(C. 3 l. 34-40).

As to claim 17 Bukow teaches the applicants having certain credentials(C. 5 l. 20-29).

As to claim 18 Bukow teaches indirectly determined applicant pool(C. 8 l. 22-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 19 and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,567,784 Bukow as applied to claims 16-18 above, and further in view of www.medquist.com; retrieved from the wayback machine; any linkage June 8, 2003. Hereinafter referred to as Medquist.

As to claims 19 and 21 Bukow teaches

Determining necessary tasks to be performed(C. 1 l. 33-37).

Submitting the need for someone to perform the certain tasks that are capable of being performed over the internet(C. 2 l. 60-65).

Choosing a candidate that meets the requirements of the task(C. 3 l. 34-40).

However, Bukow fails to teach receiving the complete work from the applicant and paying the applicant.

Medquist teaches receiving the completed work at the clinic(Pg. 18 ¶B)

Medquist further teaches paying the applicant for the amount of work completed.(Pg. 14 ¶G). It would have been obvious to one of ordinary skill in the art to

pay the user for the work completed as this is a normal practice in any business environment. If payments are being made for work done the work will cease to be complete.

As to claims 22-27 Bukow fails to teach the atomic unit of work being a reviewing a document for typographical error. Medquist the work being reviewing dictation with accuracy. The examiner notes the type of atomic work that is being performed or the information it is being performed on is non-functional descriptive data. The method of identifying a qualified candidate to perform the atomic unit would be performed the same regardless of the type of work being requested.

As to claims 28 and 29 Bukow teaches the specific criteria requested in order to perform the task being requested.(C. 2 l. 66-67) C. 3 l. 1-2). Again, the applicant notes that the type of criteria being requested is again non-functional descriptive material. It would be an obvious variant to use different criteria needed depending on the difference in tasks needed to be completed.

As to Claim 30 Bukow teaches criteria as certification levels(C. 3 l. 10-12).

As to claims 31-32 Bukow teaches criteria a level of previous experience.

(10) Response to Argument

Rejection of claims 16-19 and 21-32 under 35 USC 101.

The appellant argues that “receiving or transmitting work electronically” is not insignificant extra solution activity. The examiner notes that the simple sending and receiving of the work is not the significant to the invention. The significance of the invention is the determination of work and the selection of the candidate who can

perform the needed work. The examiner further notes that as to claim 16 the claim does not positively claim that the work is being sent electronically over a network but rather that the work is "capable" of being sent over the internet to an employer computer system. The limitation of "electronically providing....notification" is simply sending an email to the applicant or posting on a websites a job request, this is not a significant step in the method. Again, as to claim 19 the act of receiving the work over the internet is not the significant function of the claimed invention, the significant steps of the claims are the separating the tasks, determining work to perform and selecting the candidate. The receiving the work over the internet is simply sending an attached document via email to the employer computer system.

(10) Response to Argument

Rejection of Claims 21-32 under 35 USC 112 1st Paragraph

The appellant argues that its is well "established" independent contractor is and sites the definition from Black's Law Dictionary, and makes that statement that although the specification does not use the term "independent individual contractor" it "contemplates" that participants in the EWP WILL be "independent contractors".

The examiner notes the lack of written description is not given because it is not understood by what is meant by and "Independent Individual contractor" but rather that the specification does not support the narrowing of the claims to limit participants to "individual independent contractors". The examiner further notes that the appellant has given a definition of an "independent contractor" vs. and "individual independent

contractor", as claimed and the basis for the rejection, which again is a narrower scope than the definition.

The appellant sites sections from the specification that teach participants being able to choose work-hours, geographic location type of work. The examiner notes this could simply be a telework program and/or flexible schedule program with in a company. The appellant further points to sections that shows the participants working anonymously for the employer. Nothing in the disclosure with lead one of ordinary skill in the art to know that a participant in the EWP WILL be an "individual independent contractor". The appellant intends to argue his interpretation of the disclosure as obvious to one of ordinary skill in the art. The applicant has the burden of showing that a person of skill in the art would have understood, at the time the application was filed that the description requires the limitation. Hyatt, 47 USPQ 2d @1131.

By way of the example the examiner draws attention to the Medquist reference, Medquist is a company that employees individual to do medical coding for various different health facilities. As originally claimed Medquist alone could read on Claim 21 as assigning their employees(participants) to code medical bills for certain facilities based on the facilities needs and the employees skills. As currently claimed each employee would have to be their own contractor, be their own **individual** company.

Rejection of Claims 16-18 under 35 USC 102(e) by US Patent 6,567,784

Bukow

The appellant argues that Bukow fails to teach an “atomic unit of work” and sites appellants disclosure defining an atomic unit of work as “activities that a business could not or would not for practical reasons, further subdivide.”

The examiner notes that scope of appellants definition is not limited as it is not a closed definition, the appellants examples of “atomic units” are simply that, examples but do not limit or close the scope of what is encompassed by the definition.

The appellant further argues that the action is addressing limitations not claims “Determining **SEVERAL** tasks necessary to be performed.” The examiner notes that tasks to be performed are what need to be done, the type of work needed to be completed. As C. 1 l. 33-37 discloses a company needed to develop a website(task) must subcontract the art work (atomic units).

The examiner draws attention to C. 2 l. 53-60 in which Bukow describes what can be considered “activities”/tasks as “proofreading, researching or some other type of activity” which are “several tasks”.

Applicant claims that Bukow does not describe “breaking down” the task into several types of atomic units”. The examiner notes that although the claims “determine several types” the proceeding steps simply require “at least one” type of atomic unit to be performed. Furthermore, Bukow teaches “mandatory characteristics” that are evaluated to determine if a worker and do the task(artwork).(c. 1 l. 60-67).

The appellant argues that Bukow fails to teach “negation of payment”. The examiner notes that Bukow discusses in several passages. Setting a cost for what a

worker will work for and accepting what a worker submits as their cost(C. 3 l. 34-40.C. 6 Table 1 l. 1-12 C. 5 l. 63-66).

The appellant argues that “artwork” as part of developing a website is not a description of an activity that a business could not, or would not for practical reasons further subdivides. The appellant fails to provide support for why website artwork would not qualify as “atomic unit of work”. Appellant argues that Bukow teaches matching the “entire project” with works. The examiner notes the project being matching in this case is the website artwork with is part of (or a divided portion) of the larger project the entire website. It appears the appellant is arguing a simply use of different terms, when appellants terms are given non-limiting open definitions.

The appellant further argues that Bukow fails to teach determining pool of candidates via "indirect message delivery process". The appellant argues that Bukow teaches only "interested" candidates can contact the project creator. The examiner notes that the system first identifies candidates that match the user skills with the project needs before passing on the match list on and indicating to a candidate that they are a match for a certain project.(C. 5 l. 30-38 and C. 8 l. 1-22). Additionally, the appellant fails to teach how the appellants claim language differs from the prior art but simply just states it is not disclosed.

**Rejection of Claims 19 and 21-32 under 35 USC 103(a) Bukow in view of
www.medquist.com**

The appellant argues that Bukow fials to teach “separating tasks into subparts”. The examiner notes that Bukow teaches the example of website development in which

the contractor must sub contract out the artwork portion of the website. This in essence is dividing the website(task) into subparts(artwork) that can be performed on an atomic unit basis. Bukow further teaches (C. 2 l. 62-65) these subparts are can be done "free lance" which inherently is someone who provides services as needed hourly, daily as needed rather than a regular employee. Additionally, as stated before, the examiner notes that scope of appellants definition in not limited as it is not a closed definition, the appellants examples of "atomic units" are simply that, examples but do not limit or close the scope of what is encompassed by the definition.

The appellant further argues that the action is addressing limitations not claims "Determining **SEVERAL** tasks necessary to be performed." The examiner notes that tasks to be performed are what need to be done, the type of work needed to be completed. As C. 1 l. 33-37 discloses a company needed to develop a website(task) must subcontract the art work (atomic units).

The examiner draws attention to C. 2 l. 53-60 in which Bukow describes what can be considered "activities"/tasks as "proofreading, researching or some other type of activity" which are "several tasks".

The appellant argues that Bukow fails to teach "offering to individual independent contractors in the identified group(meeting qualifications) the opportunity to perform the type of atomic units." The examiner notes this limitation is interpreted to read according to Bukow that once candidates are determined to meet the qualifications requested by the project creator the candidates are sent the project description for their review. (C. 8 l. 16-35) teaches the candidate posting work interests in art work and the system

matches her with the contractor searching for a candidate to do artwork for the websites. Thus the candidate has been "Offered the opportunity" to perform a unit of work". The appellant is further Directed to Fig. 3 in which it displays the matches and past projects.

The appellant argues that the examiner has failed to establish a *prima facie* case of obviousness. The appellants cites the May 3, 2007 Memorandum from Deputy Commissioner for Patent Operations, from Margaret Focarino in which examiners are still required to at least identify " the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claims." The appellant asserts the action lacks this requirement by making a "hypothetical" combination without any explanation. The examiner notes that a hypothesis is an interpretation of a practical situation which is assumed to be true unless proven otherwise. The examiner also believes the statement made in the office action dated July 27, 2006 "It would have been obvious to one of ordinary skill in the art to pay the user for the work completed as this is a normal practice in any business environment"(knowledge of the art) and if payment are not made for work done the work will cease to be completed(explanation), meaning, if the worker is not being paid, they will stop performing/doing work they are not getting paid for any longer. Therefore, the examiner believes the burden has been met to provide a *prima facie* case of obviousness based on the knowledge of those ordinary and common in the sill of employment and payment of work and contracts.

The appellant further argues that Medquist fails to describe in any way the activities of the person who actually performed with work, with respect to the limitation

of the work being received over the internet. The examiner notes, the claims do not describe or claim in any way activities of the person who actually performed the work, they simply claim the work is being sent over the internet, not that the actual work is being performed over the internet. However, for sake of showing the state of the art the examiner draws the Board and appellants attention to Pg. 6 ¶8 which states that using connectivity software, Medquist can also enter data directly into your computer system in order to document the outcome of the coding function, if desired. In order to accomplish this we will require electronic authorization to access the system. Therefore if this were claimed, Medquist teaches the types of activities that the worker is performing over a network.

As to appellants argument that Medquist does not teach the limitations of claims 22-27. The examiner notes these claims were rejected under Bukow not Medquist, as such the argument is moot and does not apply properly to the reference as used in the rejection. the examiner notes the dependent claims are "wherein" clauses that do not positively recite any new steps or functions actually being performed, and therefore is not given patentable weight. As noted in the rejection, the steps of the method would be performed the same regardless of what type of work/atomic units are to be performed and the qualifications of the person performing them. The claims do not positively claim the completion of ANY type of work nor do they positively claim any use of the candidates skills critiria. As such, the prior art of record teaches the positively claimed limitations.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Traci L Casler/

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